

### REMARKS

Claims 24-79 are pending in the present application. In this paper, Applicants cancel claims 25, 45, 46, 53, 54, and 57-79, and add new claims 80-103. The new claims are supported by the specification. No new matter has been added.

#### **I. Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 36, 38, 44, 45, and 62-77 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have obviated this rejection by amending the last conjunction in claim 36, amending claim 38 to remove the “where appropriate” phrase, amending claim 44 to further limit the term “wax-like”, and canceling claims 45 and 62-77. Accordingly, Applicants request that this ground for rejection be withdrawn.

#### **II Rejection under 35 U.S.C. § 101**

Claims 62-77 stand rejected under 35 U.S.C. § 101 for reciting improper process claims. Applicants have obviated this rejection by canceling claims 62-77, and according request that this ground for rejection be withdrawn.

#### **III. Rejection under 35 U.S.C. § 102(b)**

Claims 24-34, 36, 38-49, 51-56, 58-60, 78 and 79 stand rejected under 35 U.S.C. § 102(b) as anticipated by Sinclair-Day et al. (U.S. Patent No. 5,470,893). Applicants respectfully traverse the rejection.

The Examiner states on page 3 of the Office Action that Sinclair-Day discloses Applicants’ composition in Example 4 and alleges that “all properties are inherent in the composition.” Applicants submit that Sinclair-Day is silent as to the following two elements in Applicants independent claim 24: “the epoxy value of the polymerization product is from 1 to 8 equivalents of epoxy groups per kilogram”; and “the overall ratio of epoxy equivalents of [the polymerizations product] to metal equivalents of [the metal salt or metal complex] is from 0.2 to

120.” If the polymerization product in Sinclair-Day et al. is the “Glycidyl-functional polyacrylate” in Component B, said compound is not described in Sinclair-Day with enough specificity to permit one of skill in the art to recognize that said compound would satisfy the foregoing claim elements. All that Sinclair-Day provides is a generic chemical name, with no specific trade name or other information that might inherently suggest the claim elements. The same arguments apply to independent claim 26, as well as the other independent claims 83, 91, 101 and 102.

The MPEP at § 2112, pages 2100-52 to 2100-53, provides case law to support the proposition that the Examiner must provide rationale or evidence tending to show inherency. In particular:

“In relying upon the theory of inherency, the examiner must prove a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Based on the arguments above, and the weight of authority, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case of inherency based on Sinclair-Day, and the rejection should be withdrawn.

#### IV. Rejection under 35 U.S.C. § 103(a)

Claims 24-61, 78 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lauterbach (U.S. Patent No. 4,614,674) in view of Chang et al. (U.S. Patent No. 5,472,649), Foukes et al. (U.S. Patent No. 5,536,785) or Chasser et al. (U.S. Patent No. 6,069,221). Applicants respectfully traverse the rejection.

Applicants submit that Lauterbach fails to teach or suggest the specific epoxy value, nor the overall ratio of epoxy equivalents to metal equivalents, recited in Applicants’ independent

claims 24 and 26. In addition, as the Examiner states on page 4 of the Office Action, Lauterbach fails to teach or suggest a separate epoxy polymer and epoxy cross-linking agent.

Applicants submit that Chang et al, Foukes et al. and Chasser et al., whether considered alone or in combination, do not overcome all of the deficiencies of Lauterbach. None of these references disclose epoxy value, the inclusion of a metal salt or metal complex, much less the overall ratio of epoxy equivalents to metal equivalents, as recited in Applicants' claims.

Applicants respectfully request that the rejection be withdrawn.

### CONCLUSION

Applicants believe that the present application is now in condition for allowance.  
Favorable consideration of the application as amended is requested.

Respectfully submitted,

Proskauer Rose LLP

Date: November 13, 2003

By Kristin H. Neuman  
Kristin H. Neuman  
Attorney for Applicants  
Registration No. 35,530

Proskauer Rose LLP  
Patent Department  
1585 Broadway  
New York, NY 10036-8299  
Tel. (212) 969-3385 (direct)  
Fax (212) 969-2900